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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,460	01/14/2002	Lee Edward Ciampi	ABINITI.001CP1	3155

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EXAMINER
BOS, STEVEN J

ART UNIT	PAPER NUMBER
1754	8

DATE MAILED: 05/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

8/m8

Office Action Summary

Application No.	Applicant(s)
10/047,460	Ciampi et al
Examiner	**Art Unit**
Steven Bos	1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Mar 12, 2003*.

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-3 and 19-36* is/are pending in the application.

4a) Of the above, claim(s) *19, 20, and 29-31* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-3, 21-28, and 32-36* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims *1-3 and 19-36* are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *4,5*
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-3,21-28,32-36, drawn to a method of making a ferrate, classified in class 423, subclass 594.1.

II. Claims 19,20,29-31, drawn to an electrochemical method of making a ferrate, classified in class 205, subclass 543.

The inventions are distinct, each from the other because of the following reasons: Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Sam K. Tahmassebi on March 31, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-3,21-28,32-36. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19,20,29-31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

The use of the trademark OXONE has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27,35 contains the trademark/trade name OXONE. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or

trade name. In the present case, the trademark/trade name is used to identify/describe an oxidizing agent and, accordingly, the identification/description is indefinite.

Claims 22,23,25,27,33-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 22, "said additional aqueous solution" lack(s) proper antecedent basis in the claim(s).

In claims 23,25,27,33-35, improper Markush language is used which renders the claims indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,21-23,25-27,32-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Deininger '573. See the figure and col. 5 and the claims.

Claims 1-3,21-25,27,32-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson '994. See cols. 6-9 and the claims. The instantly claimed delivering at least a portion ... to the mixing chamber or reaction chamber is a nominal step which is taught by "isolating the ferrate" in col. 7.

Claims 1-3,21-25,27,28,32-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Mills '090. See example 1. The instantly claimed delivering at least a portion ... to the mixing chamber or reaction chamber is a nominal step which is taught by filtering the ferrate in example 1.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3,21-25,27,32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson '994 in view of Deininger '573.

Johnson teaches the instantly claimed process as shown above but may differ in that it does not specifically teach delivering at least a portion of the ferrate to a site of use that is proximal to the mixing or reaction chamber.

Deininger teaches or at least suggests such delivering of at least a portion of the ferrate in the figure in a process of making a ferrate similar to that of Johnson.

It would have been obvious to one skilled in the art to deliver the ferrate as taught by Deininger in the process of Johnson because each reference is directed to a similar process of making ferrates.

Claims 1-3,21-25,27,28,32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills '090 in view of Deininger '573.

Mills teaches the instantly claimed process as shown above but may differ in that it does not specifically teach delivering at least a portion of the ferrate to a site of use that is proximal to the mixing or reaction chamber.

Deininger teaches or at least suggests such delivering of at least a portion of the ferrate in the figure in a process of making a ferrate similar to that of Mills.

It would have been obvious to one skilled in the art to deliver the ferrate as taught by Deininger in the process of Mills because each reference is directed to a similar process of making ferrates.

Claims 1,3,21,22,27,35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison '553 in view of Deininger '573.

Harrison suggests the instantly claimed process in example 1 but may differ in that it does not specifically teach delivering at least a portion of the ferrate to a site of use that is proximal to the mixing or reaction chamber.

Deininger teaches or at least suggests such delivering of at least a portion of the ferrate in the figure in a process of making a ferrate similar to that of Harrison.

It would have been obvious to one skilled in the art to deliver the ferrate as taught by Deininger in the process of Harrison because each reference is directed to a similar process of making ferrates.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Bos whose telephone number is (703) 308-2537. The examiner is on the increased flexitime program schedule and can normally be reached between 8AM and 6PM Monday through Friday. The FAX No. for After Final amendments is 703-872-9311; for all others it is 703-872-9310. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0661.

Steven Bos
Primary Examiner
Art Unit 1754